



13 MAR 2007

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In re Application of
Ike et al.
Application No. 10/518,986
PCT No.: PCT/JP02/11181
Int. Filing Date: 28 October 2002
Priority Date: 10 July 2002
Atty. Docket No.: F-8518
For: Paper Feed Roller And
Fabrication Method Thereof

COMMUNICATION

This is in response to the "Petition Under 37 C.F.R. § 1.42 and § 1.47(a)" filed on 18 September 2006.

DISCUSSION

In a Decision mailed on 15 June 2006, the petition under 37 CFR 1.42 filed on 26 January 2006 was dismissed without prejudice because

Counsel states that "the second inventor, Kazuhiro OOSAKI, has passed away and has not signed the Declaration. Inspection of the declaration filed on 26 January 2006 reveals that it nominates and provides citizenship, residence and postal address information for Kazuhiro Oosaki, but it has not been signed by and does not provide citizenship, residence and postal address information for an individual or individuals indicated to be a legal representative (or all of the heirs) of Kazuhiro Oosaki, as required for relief under 37 CFR 1.42.

Meanwhile, counsel also refers to "a Declaration (with Exhibits (A) to (K)) executed by Toshiji SUGA," who appears from the evidence of record to be an employee of an assignee, SUNCALL CORPORATION, and whose statements include statements related to the issue of whether the wife of the deceased inventor refused to execute an oath or declaration or could not be found or reached after diligent effort, per 37 CFR 1.47(b).

Based on the totality of the evidence presented, it is unclear what type of relief counsel is requesting (i.e., whether relief is sought under 37 CFR 1.42, under 37 CFR 1.47, or under both 37 CFR 1.42 and 1.47). In the event that relief is sought under 37 CFR 1.42, counsel is required to satisfy all of the requirements of that regulation, including presenting an oath or declaration stating all of the required facts and signed on behalf of the deceased inventor by his legal representative or all of his heirs. In the event that relief is sought under 37 CFR 1.47(b), counsel's attention is respectfully directed to MPEP 409.03(c), which states that

37 CFR 1.47 should not be considered an alternative to 37 CFR 1.42 or 35 U.S.C. 117 since the language "cannot be found or reached after diligent effort" has no reasonable application to a deceased inventor. In re Application Papers Filed September 10, 1954, 108 USPQ 340 (Comm'r Pat. 1955). See 37 CFR 1.42 and MPEP § 409.01. However, 37 CFR 1.47 does apply where a known legal representative of a deceased inventor cannot be found or reached after diligent effort, or refuses to make application. In such cases, the last known address of the legal representative must be given (see MPEP § 409.03(e)).

In the event that counsel is seeking relief under BOTH 37 CFR 1.42 AND 37 CFR 1.47(b), the oath or declaration should be prepared for signature on behalf of the deceased inventor by his legal representative (or all of his heirs) per 37 CFR 1.42, and counsel should then provide the appropriate showing under 37 CFR 1.47(b) why the absence of the signature(s) of the legal representative (or all heirs) should be excused.

In response, petitioner has provided a declaration signed by joint inventor Takashi IKI, and naming deceased joint inventor Kazuhiro OOSAKI. Petitioner seeks relief under 37 CFR 1.47(a) for the absence of the signature of Mr. Oosaki's legal representative, Mrs. Machiko Oosaki. Thus, treatment under 37 CFR 1.42 and 1.47(a) is appropriate.

Submission Under 37 CFR 1.42

37 CFR 1.42 provides in part that

In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent.

Meanwhile, 37 CFR 1.497(b)(2), as amended effective 08 September 2000, provides that

If the person making the oath or declaration is not the inventor (§§ 1.42, 1.43 or 1.47), the oath or declaration shall state the relationship of the person to the inventor, and, upon information and belief, the facts which the inventor would have been required to state. If the person signing the oath or declaration is the legal representative of a deceased inventor, the oath or declaration shall also state that the person is a legal representative and the citizenship, residence and mailing address of the legal representative.

Inspection of the declaration filed on 18 September 2006 reveals that the document signed by Mr. Iki does not indicate that Mr. Oosaki is deceased. It also does not provide the name, relationship (e.g., "legal representative" or "sole heir"), citizenship, residence or mailing address of Mrs. Oosaki, the legal representative alluded to in the petition. However, petitioner has provided a second declaration document which nominates the same inventive entity as the international application, indicates that Mr. Oosaki is "deceased," and enumerates the citizenship, residence and postal address information pertaining to both Mr. Oosaki and his "legal representative," Mrs. Machiko Oosaki. However, this declaration is defective in that it has not been signed on behalf of Mr. Oosaki, nor has the absence of her signature been excused per

37 CFR 1.47(a)(see below). Furthermore, the declaration is not in compliance with 37 CFR 1.69(b), which provides that

Unless the text of any oath or declaration in a language other than English is in a form provided by the Patent and Trademark Office or in accordance with PCT Rule 4.17(iv), it must be accompanied by an English translation together with a statement that the translation is accurate, except that in the case of an oath or declaration filed under § 1.63, the translation may be filed in the Office no later than two months from the date applicant is notified to file the translation.

Specifically, the translation does not appear to be accompanied by a statement that the translation is accurate.

Petition Under 37 CFR 1.47(a)

Petitioner states that the Mr. Oosaki's legal representative, Machiko Oosaki, "cannot be found or reached after diligent effort," and urges that the absence of her signature on the declaration be excused on this basis.

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

Regarding requirement (1), the petition fee was paid on 18 September 2006.

Regarding requirement (2), petitioner alleges that Mrs. Oosaki has moved, and that she could not be found or reached after diligent effort. Counsel's attention is respectfully drawn to MPEP 409.03(d), which states in part:

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made. The fact that a nonsigning inventor is on vacation or out of town and is therefore temporarily unavailable to sign the declaration is not an acceptable reason for filing under 37 CFR 1.47. Furthermore, the fact that an inventor is hospitalized and/or is not conscious is not an acceptable reason for filing under 37 CFR 1.47. 37 CFR 1.43 may be available under these circumstances. See MPEP § 409.02. Such a petition under 37 CFR 1.47 will be dismissed as inappropriate.

The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included >in the< statement of facts. It is important that the statement contain facts as opposed to conclusions.

The petition is accompanied by a "Declaration of Toshiji Suga In Support For Petition" which states that, on 28 July 2006, Toshiji Suga sent correspondence to Mrs. Oosaki which included a copy of the application papers and a declaration, and which requested that she sign and return the executed declaration. Mr. Suga further states that the Japanese Post Office returned the correspondence in question as undelivered, because "Mrs. Machiko OOSAKI has moved and now has an unknown address." These statements are corroborated by copies (and English translations) of a letter to Mrs. Oosaki dated 28 July 2006, a postal receipt dated "18.7.28," a stamped envelope, and an envelope marked as undelivered because "It was impossible to deliver because the changed new address is unknown." However, petitioner has not adequately established that Mrs. Oosaki could not be found or reached after diligent effort because the petition and supporting documents do not demonstrate diligent efforts undertaken to identify Mrs. Oosaki's new address. For instance, petitioner has not provided a showing as to any internet searches, telephone directory searches, consultations of official residence documentation, or inquiries made of any of Mrs. Oosaki's known associates (if any). In the absence of an appropriate showing of efforts made to locate Mrs. Oosaki, it would not be appropriate to conclude that she "could not be found or reached after diligent effort" within the meaning of 37 CFR 1.47(a).

Regarding requirement (3), the petition provides the last known address of the non-signing legal representative, Mrs. Machiko Oosaki.

Regarding requirement (4), the declaration is not acceptable at this time for the reasons stated above in the discussion concerning 37 CFR 1.42 (specifically, because the declaration is not in compliance with 37 CFR 1.69(b)).

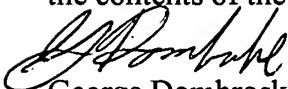
CONCLUSION

The declaration is **NOT ACCEPTED** under 37 CFR 1.42, without prejudice.

The petition under 37 CFR 1.47(a) is **DISMISSED**, without prejudice.

A proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are available. Failure to file a timely response will result in **ABANDONMENT**.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, P.O. Box 1450, Mail Stop PCT, Alexandria, VA 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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